

The Examiner in his Response to Arguments at page 6 of the final Office Action rejects the Applicants' position and maintains his rejection. Nonetheless, Applicant respectfully submits that the claims are patentable on the following basis and request reconsideration.

Establishing a Special Race as One of a Plurality of Races

An express limitation of claims 1 and 5 relates to running a plurality of races. A further express limitation of the claims relates to establishing a special race as a selected one of a plurality of races. There is no teaching of the establishment of a special race in any prior art reference.

The Examiner comments that Dickinson teaches selectability because it is taught that only the top score of the top player is selected for display, not the score of every player. However, this comment does not address the clear and express limitation in the claim to establishing a special race. Nothing in the combination of Dickinson, NHL Faceoff or Nagao et al. concerns a selection of one of a plurality of races as a special race. NHL Faceoff does not relate to races at all. Dickinson mentions auto racing, but has no teaching related to plural races. Nagao et al makes a brief mention of a current race and a future race at col. 12, but does not contain any teaching with regard to making any race "special." There is no teaching of how or why one race would be distinguished over another race. The Nagao patent is silent in this regard.

The simple fact is that none of the prior art references teach this step or related structure. This feature has not been addressed by the Examiner in his rejection. Accordingly, Applicant respectfully requests the Examiner to consider this feature and its distinctiveness over the teaching of the prior art taken alone or in combination. Only impermissible hindsight would lead the Examiner to obtain the idea of having a special race be selected out of a plurality of races from the cited prior art.

Moreover, this feature is even more significant in combination with other limitations of the claims.

Pre-registration of Character Name

In the previous amendment, Applicant asserted that the present invention was distinguishable over the prior art because there was no use of a player's name that was pre-registered with a racing member. Nagao has no such teaching by the Examiner's admission. Dickenson requests a name after a game or games have been played. NHL Faceoff allows a player to enter his name and assign it to a specific hockey player, but the assignment has nothing to do with a racing game or with "pre-registration."

The Examiner rejects the Applicants' argument that a player's name is not registered until the end of the game in Dickinson. The Examiner asserts that it would be obvious to pre-register a name in Dickinson based upon the teachings that a character may be pre-registered in NHL Faceoff. However, the Examiner's position cannot be supported.

First, it must be noted that Dickinson teaches precisely the opposite approach. The Examiner has given no reason why one of ordinary skill would act contrary to the express teachings of Dickinson, namely the registration of a player only after he has achieved a top score in a game. Second, the reason for post play entry in Dickinson is that such games did not want players to waste time entering their name, when they could be spending that time playing the game for a fee. In other words, the profit motive leads one of ordinary skill away from the pre-registration of the present invention. Third, the only reason for having a name entered in Dickinson is to give recognition to a top skillful player; unskilled players have no expectation of winning and have no reason to enter their name. In this regard, the top player's name remains in the game until another player achieves a better score. In short, the entire approach in Dickinson, which is based on a level of skill of the player, is contrary to the teachings of the present invention, which is a game of luck and statistical outcome.

Combination of References

Finally, Applicants have submitted that one of ordinary skill in the art would not look to diverse games, such as racing games and hockey games, for features that may be combined, particularly in the manner that would anticipate or render obvious the claimed invention. The

Examiner asserts that such argument is conclusory as no evidence has been provided as to why the combination is not obvious.

Applicants would disagree. It is the Examiner's duty to prove that a combination is obvious, and not the Applicants job to prove unobviousness. Nonetheless, Applicants have demonstrated above that by virtue of the very nature of the racing and hockey games, features of a hockey game would not be applicable to a racing game. Naming horses or racing members, as well as naming the game or race itself, after a player on the basis of a pre-registered name and the relative record of a player, would not be a feature found obvious from a hockey game. There would be no attraction to having a hockey character named after a player automatically. A game player wants to customize his character's features (speed, size, position, etc.) and then give it his name. Thus, there would be no name assigner or assigning step, as claimed. Further, in hockey, there is no tradition of naming a game, stadium, period or tournament after a person as a recognized honor, unless that person was no longer living (e.g., "Lady Bing Trophy" or "Stanley Cup."). In other words, there is no culture surrounding a hockey game that would lead one to adapt the features of NHL Faceoff to a racing game.

Similarly, there is nothing in the racing games of Nagao et al or Dickinson that would lead one to look to NHL Faceoff for features that could be adopted in a racing game.

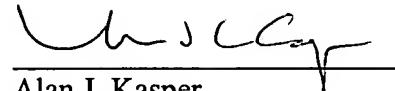
In short, Applicant respectfully submits that, for at least the foregoing reasons, the invention as set forth in the rejected claims is patentable.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.116
10/002,156

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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